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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/009,191	09/09/2002	Henry Tebeka	214277US67PCT	8603

22850 7590 12/15/2004

OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.  
1940 DUKE STREET  
ALEXANDRIA, VA 22314

EXAMINER

ESCALANTE, OVIDIO

ART UNIT	PAPER NUMBER
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2645

DATE MAILED: 12/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/009,191

**Applicant(s)**

TEBEKA, HENRY

**Examiner**

Ovidio Escalante

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 01 September 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 13-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 13-27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 September 2002 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>2/28/02;3/12/2002</u> . | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. This action is in response to applicant's preliminary amendment filed on September 9, 2002. **Claims 13-27** are now pending in the present application.

#### ***Information Disclosure Statement***

2. The information disclosure statement submitted on February 28, 2002, March 12, 2002 was received. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly the information disclosure statement is being considered by the examiner.

3. The information disclosure statement filed September 1, 2004 fails to comply with 37 CFR 1.98(a)(1), which requires a list of all patents, publications, or other information submitted for consideration by the Office. It has been placed in the application file, but the information referred to therein has not been considered.

#### ***Drawings***

4. The drawings are objected to because a LEGEND for each reference number is required. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement

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Sheet” in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Specification***

5. The following guidelines illustrate the preferred layout for the specification of a utility application. These guidelines are suggested for the applicant's use.

#### **Arrangement of the Specification**

As provided in 37 CFR 1.77(b), the specification of a utility application should include the following sections in order. Each of the lettered items should appear in upper case, without underlining or bold type, as a section heading. If no text follows the section heading, the phrase “Not Applicable” should follow the section heading:

- (a) TITLE OF THE INVENTION.
- (b) CROSS-REFERENCE TO RELATED APPLICATIONS.
- (c) STATEMENT REGARDING FEDERALLY SPONSORED RESEARCH OR DEVELOPMENT.
- (d) INCORPORATION-BY-REFERENCE OF MATERIAL SUBMITTED ON A COMPACT DISC (See 37 CFR 1.52(e)(5) and MPEP 608.05. Computer program listings (37 CFR 1.96(c)), “Sequence Listings” (37 CFR 1.821(c)), and tables having more than 50 pages of text are permitted to be submitted on compact discs.) or  
REFERENCE TO A “MICROFICHE APPENDIX” (See MPEP § 608.05(a). “Microfiche Appendices” were accepted by the Office until March 1, 2001.)
- (e) BACKGROUND OF THE INVENTION.
  - (1) Field of the Invention.
  - (2) Description of Related Art including information disclosed under 37 CFR 1.97 and 1.98.
- (f) BRIEF SUMMARY OF THE INVENTION.
- (g) BRIEF DESCRIPTION OF THE SEVERAL VIEWS OF THE DRAWING(S).
- (h) DETAILED DESCRIPTION OF THE INVENTION.
- (i) CLAIM OR CLAIMS (commencing on a separate sheet).
- (j) ABSTRACT OF THE DISCLOSURE (commencing on a separate sheet).
- (k) SEQUENCE LISTING (See MPEP § 2424 and 37 CFR 1.821-1.825. A “Sequence Listing” is required on paper if the application discloses a nucleotide or amino acid sequence as defined in 37 CFR 1.821(a) and if the required “Sequence Listing” is not submitted as an electronic document on compact disc).

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 21,22,24 and 27 are rejected under 35 U.S.C. 102(e) as being anticipated by Chinni et al. US Patent 6,205,135.

***Regarding claim 21***, Chinni teaches a telephone center (100,200) having at least one IP address (188.333.409.100) in a computer communication network, (fig. 1; col. 6, lines 16-30), the telephone center comprising:

an exchange device to communicate at least one IP address to or from at least one other telephone utilizing, (col. 6, lines 20-53):

(1) at least one of a telephone network and (2) a server, (fig. 1; col. 6, lines 31-53); and

a switching device to establish a link with one of the at least one other telephone center, via a computer communication network utilizing an IP address of the one of the at least one other telephone center, (fig., 1; col. 6, lines 4-53).

***Regarding claim 22***, Chinni, as applied to claim 21, teaches wherein the link is a permanent link, (fig. 1; col. 6, lines 16-35).

**Regarding claim 24**, Chinni, as applied to claim 20, teaches wherein the switching device is shared between several subscribers, (fig. 1; col. 2, line 59-col. 3, line 7).

**Regarding claim 27**, Chinni, as applied to claim 21 teaches wherein the computer communication network comprises the Internet, (fig. 1; col. 6, lines 16-35).

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

10. Claims 13-20,23,25 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chinni et al. US Patent 6,205,135 in view of Lee et al. WO 98/11704.

**Regarding claims 13 and 17**, Chinni teaches a method and system for communicating between at least two users (151-n,152-n), with each user having a telephone device in a telephone network, and with each telephone device being connected via a local loop in the telephone network, to a telephone center managed by a telecommunications operator with which the user has taken a subscription, (col. 1, lines 65-col. 2, line 22), comprising:

establishing a link, via a computer communication network (Internet), between the telephone centers, (col. 6, lines 16-35; fig. 1);

establishing a communication, via the telephone network, between both users, with the users, (col. 4, lines 45-64; fig. 1);

wherein a cost of the communication equals: a cost of a local call to the corresponding telephone center plus a fraction of a cost of subscription to the computer communication network, (fig. 3; col. 1, lines 20-45; col. 4, lines 29-34).

While Chinni teaches of using both a circuit network connection and a packet network connection Chinni does not specifically teach requesting the telephone centers to switch the communication, from the telephone network to the computer communication network.

Lee teaches that it was well known in the art to have a control device switch the communication, from the telephone network to the computer communication network, (page 13, lines 9-19) so that the cost of the connection can be lowered during a call.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Chinni by switching during the communication from a telephone network connection to a computer network connection so that cost of the connection can be lowered during a call.

***Regarding claims 14, 18 and 23***, Chinni in view of Lee, as applied to claims 13 and 17, teaches wherein the requesting step comprises using at least one key on a keypad of the telephone device, (page 13, lines 9-19). As stated above, it would have been obvious to switch during the communication so that cost of the connection can be lowered during a call.

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**Regarding claims 15 and 19**, Chinni, as applied to claims 13 and 17, teaches wherein the step of establishing comprises establishing a permanent Internet connection, (fig. 1; col. 6, lines 16-35).

**Regarding claims 16 and 20**, Chinni, as applied to claims 13 and 17, teaches wherein the link is shared between several subscribers, (fig. 1; col. 2, line 59-col. 3, line 7).

**Regarding claims 25-26**, Chinni, as applied to claims 13 and 17 teaches wherein the computer communication network comprises the Internet, (fig. 1; col. 6, lines 16-35).

### **Conclusion**

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Pedersen US Patent Pub. 2003/0039346 teaches of a method for switching a PSTN call to an Internet based call during a call.

12. Any response to this action should be mailed to:

Commissioner for Patents  
P.O. Box 1450  
Alexandria, Virginia 22313-1450

or faxed to:

(703) 872-9306, (for formal communications intended for entry)

Or:

(703) 872-9306, (for informal or draft communications, please label "PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to:

220 20<sup>th</sup> Street S.  
Crystal Plaza two, Lobby, Room 1B03  
Arlington, VA 22202



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13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ovidio Escalante whose telephone number is 703-308-6262. The examiner can normally be reached on M-F (6:30AM - 5:00PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan S Tsang can be reached on 703-305-4895. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

**OVIDIO ESCALANTE**  
**PATENT EXAMINER**



Ovidio Escalante  
Examiner  
Group 2645  
December 10, 2004

O.E./oe